

REMARKS

At the time of the Office Action dated February 25, 2004, claims 2-3, 5-6 and 9-10 were pending and rejected in this application. Claims 2-3, 5-6 and 9-10 have each been amended to recite that the coin dispensing apparatus is for an automatic vending machine. The title of the invention has also been similarly amended. Claims 2 and 3 have also been amended to replace the term "second sorting unit" with "diverting unit." Independent claims 2 and 5 have been amended to clarify that the holding unit holds coins until goods are dispensed from an automatic vending machine or a user of the automatic vending machine requests return of the coins. Claims 2 and 5 have also been amended to recite that the coin storing unit supplies coins to the coin repayment unit, and the coins being temporally held in the holding cylinder are returned along a path separate from the coin storing unit. Applicants submit that the present Amendment does not generate any new matter issue.

CLAIMS 2-3 AND 5-6 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. §

112

The Examiner asserted that "the term 'sorter' ... appears to illustrate a diverter/flipper which diverts a coin or release a coin from a path to another path." This rejection is respectfully traversed.

Initially, Applicants are unsure as to what particular language in claims 2-3 and 5-6 the Examiner considers indefinite as none of claims 2-3 and 5-6 recite a "sorter" since the statement of the rejection is silent in this regard. Applicants, however, have amended claims 2 and 3 to

replace the term "second sorting unit" with "diverting unit," since element 9 in Fig. 2, which was referred to by the Examiner, corresponds to the claimed second sorting unit/diverting unit.

Claims 5 and 6 do not recite a second sorting unit, and therefore, these claims have not been amended. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 2-3 and 5-6 under the second paragraph of 35 U.S.C. § 112.

**CLAIMS 2-3, 5-6 AND 9-10 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON JONES ET AL., U.S. PATENT NO. 6,318,537 (HEREINAFTER JONES)**

The Examiner asserted that one having ordinary skill in the art would have modified Jones to arrive at the claimed invention. This rejection is respectfully traversed.

Initially, Applicants note that independent claims 2 and 5 have both been amended to recite that the coin dispensing apparatus is for an automatic vending machine and a holding unit of the coin dispensing apparatus temporally holds coins inserted into the apparatus until goods are dispensed from the automatic vending machine or a user requests return of the coins.

On page 4 of the Office Action, the Examiner asserted that claimed limitation of "when coin-returning operation is performed after coins are inserted into said coin dispensing apparatus, the inserted coins being temporally held in said holding cylinder are returned" is how coins are returned in Jones' system. The Examiner, however, has failed to supply any citation for support of this assertion. The reason why Jones fails to teach this particular limitation illustrates the difference between the claimed invention and the currency processing machine of Jones.

The present invention is directed to preventing fraud, which occurs when genuine money is obtained by inserting counterfeit money into a coin dispensing apparatus. This fraud is a result of the structure of conventional coin dispensing apparatus. The conventional coin dispensing apparatus (i) discriminates between genuine coins and counterfeit coins, (ii) sorts the discriminated coins into each coin kind, and (iii) directly stores the coins into a coin storing unit. If a coin returning lever is operated, then coins which are the same type (i.e., denomination) and number as those originally inserted are dispensed from the coin storing unit. Since the undetected counterfeit coins in the discriminating device are stored in the uppermost portion of the coin storing unit, when the coin returning lever is operated, genuine coins at the lowermost position of the coin storing unit are dispensed.

To solve this problem, the claimed invention is a coin dispensing apparatus that includes a holding unit for temporally holding the coins inserted into the apparatus until goods are dispensed from an automatic vending machine or a user requests return of the coins. If a coin return operation occurs, then the coins being temporally held in the holding unit are returned along a path separate from said coin storing unit. In this manner, counterfeit coins are not stored in the uppermost portion of the coin storing unit and genuine coins are not dispensed from the bottom portion of the coin storing unit. Instead, the temporally held coins are returned along a path separate from the coin storing unit.

In contrast, Jones is not a coin dispensing apparatus for an automatic vending machine. Instead, Jones is a currency processing machine that allows a user to change a large number of bills/coins into a smaller number of bills/coins or a receipt (column 5, lines 10-25). The

Examiner's alleged "sorting device" or "first sorting device" is the coin processing module 32, which is described as sorting non-authenticated coins from authenticated coins and directing the non-authenticated coins into a coin reject tube which leads to a dispensed coin receptacle 22 (column 5, line 65 through column 6, line 16). Once the coins have been sorted by the coin processing module 32, the coins are sent down a coin tube 38 to a coin receptacle station 40. In the statement of the rejection, the Examiner referred to feature 52, 54, 56 or feature 402a-f as corresponding to the claimed holding unit. In contrast to the claimed invention, which states that if a coin return operation occurs, coins being held in the hold unit are returned, once the coins leave the first sorting device of Jones (i.e., the Examiner's asserted coin processing module 32) and enter the claimed holding unit (i.e., the Examiner asserted features 52, 54, 56), the coins cannot be returned since the coin receptacle station 40 (which includes feature 52, 54, 56) is not connected to the coin repayment unit 22.

Fig. 20 of Jones illustrates feature 402a-f, which the Examiner cites as a second example of the claimed holding unit. On page three of the Office Action, the Examiner asserts that "bin elements (402a-f) are provided between coin storing unit (40 or 251) and the sorting unit (32 or 248). The Examiner also asserts that feature 410 in Fig. 20 corresponds to the claimed coin repayment unit. The claimed invention, as recited in amended claims 2 and 5, recites that the coins being temporally held in the holding unit are returned along a path separate from the coin storing unit. However, as illustrated in Fig. 20, only one path exists between the asserted holding unit (i.e., features 402a-f) and the outlet 22, and thus, a returned coin must pass through the coin storing unit of Jones. Therefore, Jones fails to teach or suggest that coins being temporally held in a holding unit are returned along a path separate from a coin storing unit.

Notwithstanding the differences noted above, Jones also does not teach or suggest returning temporally held coins upon a return operation after a first sorting operation. As recited in independent claims 2 and 5, the coins are temporally held in the holding unit until goods are dispensed from the automatic vending machine or a user requests return of the coins. Jones is not an automatic vending machine, and thus, one of the two conditions cannot be met. Furthermore, once the coins have been sorted between authenticated coins and non-authenticated coins, the non-authenticated coins are automatically returned to the use, and thus the other condition cannot be met. Therefore, Jones fails to teach or suggest this particular limitation. For the reasons stated above, Applicants respectfully solicit withdrawal of the imposed rejection of claims 2-3, 5-6 and 9-10 under 35 U.S.C. § 103 for obviousness based upon Jones.

In reviewing the Examiner's "Response to Arguments" on page five of the Office Action, Applicants note that the Examiner has made an assertion that does not have any legal basis. With regard to the Examiner's assertion that the plungers of Jones are equivalent to the claimed wipers, the Examiner is referred to M.P.E.P. § 2144.06 and the paragraph entitled "SUBSTITUTING EQUIVALENTS KNOWN FOR THE SAME PURPOSE." As discussed in In re Ruff, equivalency cannot be based on the mere fact that the components at issue are functional equivalents. Furthermore, in In re Scott, a decision of the Board was reversed on the basis that components that are functionally equivalent are not necessarily obvious in view of one another. Thus, even if one having ordinary skill in the art would consider the plungers disclosed by Jones to be functional equivalents of the claimed wipers, this functional equivalency alone is

Application No.: 09/653,988

insufficient to provide a motivation or suggestion to modify Jones to arrive at the claimed invention.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read 'Scott D. Paul', is written over the firm name.

Scott D. Paul
Registration No. 42,984

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 SDP/GZR:kap
Date: May 25, 2004
Facsimile: (202) 756-8087